

REMARKS

In the Office Action identified above, the Examiner rejected claims 1-4, 17-20, and 33-34 under 35 U.S.C. § 102(b) as being anticipated by Murray (U.S. Patent No. 5,699,089); rejected claims 5-8 and 21-24 under 35 U.S.C. § 102(e) as being anticipated by Moon et al. (U.S. Patent No. 6,629,000); rejected claims 9-13, 16, 25-29, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Burrows (U.S. Patent No. 6,377,530) in view of Maehashi et al. (U.S. Patent No. 6,587,641); and objected to claims 14, 15, 30, and 31 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claims 14, 15, 30, and 31. By this Amendment, Applicants amend claims 1, 5, 17, 21, and 33 and cancel claims 8 and 24. Claims 1-7, 9-23, and 25-34 are pending in this application.

I. The Rejection of Claims 1-4, 17-20, and 33-34 Under 35 U.S.C. § 102

Claims 1-4, 17-20, and 33-34 were rejected under 35 U.S.C. § 102(b) as being anticipated by Murray. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Murray fails to teach each and every recitation of claim 1.

Claim 1 recites “[a] recording and reproducing apparatus,” including *inter alia*, “means for requesting content from an external device.” Murray fails to disclose at least

this limitation. The Examiner alleges that Murray teaches this element at col. 8, lines 35-38 by disclosing “retrieving voice mail messages, email messages, fax messages and the like for the user.” (OA at 2.) Applicants respectfully disagree. Murray’s teaching of receiving voice mail messages, email messages, and fax messages is insufficient to disclose “means for requesting content from an external device,” as recited in claim 1. Indeed, col. 8, lines 30-34 of Murray indicates that the messages are retrieved from object store memory 6016. That is, Murray is silent as to requesting content from an external device. As such, Murray does not teach at least, “means for requesting content from an external device,” as recited in claim 1. Therefore, Applicants request the Examiner to withdraw the rejection of claim 1 and allow the claim.

Furthermore, Applicants have amended claim 1 to recite “means for stopping the recording of the content supplied from the external device after receiving an end-of-content notification from the external device.” Murray also fails to teach or suggest at least this element. For this additional reason, Applicants request the Examiner to allow claim 1.

Claims 2-4 depend from claim 1. As explained, claim 1 recites elements not disclosed by Murray. Accordingly, claims 2-4 are allowable over Murray for at least the same reasons as claim 1. Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Independent claims 17 and 33, although of different scope, recite elements similar to that discussed above with regard to claim 1. Applicants, therefore, submit that claims 17 and 33 are also allowable over Murray.

Claims 18-20 and 34 depend from claims 17 and 33, respectively. As explained, claims 17 and 33 recite elements not disclosed by Murray. Accordingly, claims 18-20 and 34 are allowable over Murray for at least the same reasons as claims 17 and 33. Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

II. The Rejection of Claims 5-8 and 21-24 Under 35 U.S.C. § 102

Claims 5-8 and 21-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moon et al. Applicants respectfully traverse this rejection.

Claim 5 recites “[a] recording and reproducing apparatus,” including *inter alia*, “wherein said setting means comprises means for receiving a mode setting command from the external device.” Moon et al. fails to disclose at least this limitation. The Examiner alleges that this element is taught (in the rejection of claim 8) by Moon et al. Specifically, the Examiner alleges, since Moon et al. discloses determining whether the device is connected to an external system, that in “order to determine whether the system is connected it is inherent there must be some sort of communication from the external system to the device whether it be a signal or an impedance detection it is supplied by the external system.” (OA at 6-7.) However, even if the Examiner’s allegations are presumed to be true, they nonetheless are still insufficient to meet the limitations of independent claim 5, as amended. That is, the Examiner’s allegations that it is inherent that there must be some sort of communication from the external system to the device whether it be a signal or an impedance detection does not teach or suggest “wherein said setting means comprises means for receiving a mode setting command

from the external device," as recited in claim 5. Therefore, Applicants request the Examiner to withdraw the rejection of claim 5 and allow the claim.

Claims 6-7 depend from claim 5. As explained, claim 5 recites elements not disclosed by Moon et al. Accordingly, claims 6-7 are allowable over Moon et al. for at least the same reasons as claim 5. Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claim 21, although of different scope, recites elements similar to that discussed above with regard to claim 5. Applicants, therefore, submit that claim 21 is also allowable over Moon et al.

Claims 22-23 depend from claim 21. As explained, claim 21 recites elements not disclosed by Moon et al. Accordingly, claims 22-23 are allowable over Moon et al. for at least the same reasons as claim 21. Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

III. The Rejection of Claims 9-13, 16, 25-29, and 32 Under 35 U.S.C. § 103

Applicants respectfully traverse the rejection of claims 9-13, 16, 25-29, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Burrows in view of Maehashi et al. because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed.,

Aug. 2001), quoting In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Independent claim 9 recites “[a] recording and reproducing apparatus,” including *inter alia*, “means for detecting that a sufficient amount of the content is buffered when a recording command is issued during reproduction” and “means for enabling said recording means when said detecting means detects that the sufficient amount of the content is buffered.” The Examiner admits that Burrows does not teach “a recording command” or “means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered.” (See OA at 7-8.) However, to compensate for this shortcoming, the Examiner alleges that Maehashi et al. teaches these elements. Applicants respectfully disagree. The Examiner alleges that Maehashi et al. discloses these elements by disclosing:

[w]riting limiting means constantly monitors the second predicted consumption duration worked out by second consumption duration predicting means, when the second predicted consumption is less than the second threshold value, a write inhibit flag is erected to bar writing means from writing; col. 7 lines 32-38; and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7, lines 48-51.

(OA at 8.) However, Maehishi et al. is directed to a data output apparatus in which a data stream “to input is written on a recording medium . . . and the data stream recorded on the recording medium is read out and outputted to [an] external device.” (Col. 1, line

66-Col. 2, line 4.) Further, Maehishi et al. teaches a first buffer that retains the inputted data stream before recording on the medium and a second buffer for holding the data stream read from the medium to output to the external device. (Col. 2, lines 5-11.) The passages cited by the Examiner, teach limiting the writing of the data stream to ensure that the second buffer will not underflow. (Col. 2, lines 23-28.) That is, as Maehishi et al. discloses at col. 8, lines 1-5: “video-audio data Dr1 being read is kept real-time by temporarily restricting the writing of video-audio data Dw2 in the storage device 1 on the basis of the second predicted consumption duration while video-audio data Dr1 is being read.” However, these teachings are insufficient to teach or suggest “a recording command” or “means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered” and “means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered,” as recited in claim 9. That is, there is no teaching or suggestion of detecting that a sufficient amount of the content data is buffered and “means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered,” as recited in claim 9. Applicants, therefore, respectfully request that the rejection of this claim under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Independent claim 25, although of different scope, recites elements similar to that discussed above with regard to claim 9. Applicants, therefore, submit that claim 25 is also allowable over Burrows and Maehishi et al.

Claims 10-13, 16, 26-29, and 32 depend from one of claims 9 and 25. As explained, claims 9 and 25 recite elements not disclosed by Burrows and Maehishi et al.

Accordingly, claims 10-13, 16, 26-29, and 32 are allowable over Burrows and Maehishi et al. for at least the same reasons as independent claims 9 and 25.

Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

IV. Conclusion

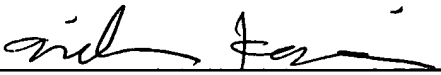
Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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